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EXAMINER	
GRANT, MICHAEL CHRISTOPHER	

ART UNIT	PAPER NUMBER
3716	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/542,996	MOSHAL, MARTIN	
	Examiner	Art Unit	
	MICHAEL GRANT	3716	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 October 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *15-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *15-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 July 2005* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 15-22** are held to claim an abstract idea and are rejected as ineligible subject matter under 35 U.S.C. 101, based upon consideration of all the relevant factors with respect to the claims as a whole.

The rationale for this finding is explained below, which is a result of careful consideration of the listed factors when analyzing the claim(s) as a whole to evaluate whether a method claim is directed to an abstract idea. These factors are not intended to be exclusive or exhaustive.

I. Factors weighing toward eligibility are:

a) Recitation of a machine or transformation: In particular, machine or transformation meaningfully limits the execution of the steps, a machine implements the claimed steps, the article being transformed is particular, an object or substance, the article undergoes a change in state or thing (objectively different function or use);

b) Practically applying a law of nature to meaningfully limit the execution of the steps; or

c) The claim is more than a mere statement of a concept: It describes a particular solution of the problem to be solved; implements a concept in a tangible way, performance of steps are observable and verifiable.

II. Factors weighing against eligibility are:

a) No recitation or insufficient recitation of a machine or transformation:

+ Insufficient involvement of the machine or transformation, merely nominally, insignificantly, or intangibly related to the performance of the steps, (e.g., data gathering, or merely recites a field in which the method is intended to be applied).

+ Machine is generically recited such that it covers any machine capable of performing the claimed step(s) or merely an object on which the method operates.

+ Transformation involves only a change in position or location of the article.

b) Improperly applying a law of nature that would monopolize a natural force or patent a scientific fact (e.g., by claiming every mode of producing an effect of that law of nature); or applied in a merely subjective determination or merely nominally, insignificantly, or tangentially related to the performance of the steps; or

c) The claim is a mere statement of a general concept: Use of the concept, as expressed in the method, would effectively grant a monopoly over the concept; or both known and unknown uses of the concept are covered, and can be performed through any existing or future-devised machinery, or even without any apparatus; or states only a problem to be solved; or general concept is disembodied; or mechanism by which the step(s) are implemented is subjective or imperceptible.

+ Examples of general concepts: Basic economic practices or theories, basic legal theories, mathematical concepts, mental activity, interpersonal relations or

relationships, teaching concepts, human behavior, and instructing how business should be conducted.

Claim 15 is ineligible subject matter because its claimed limitations include no recitation or an insufficient recitation of a machine or transformation. For example, the limitations stated in the claim could be performed by a person without the aid or involvement of a machine. As well as no article is described by the claim to be transformed into providing a different function or for a different use.

3. **Dependent Claims 16-22** when analyzed as a whole are held to be ineligible subject matter and are rejected under 35 U.S.C. 101, because the additional recited limitations they contain fail to establish that the claims are not directed to an abstract idea. The additional recited limitations stated by these claims fail to include sufficient recitations to a machine or transformation.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 15-30** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. **In regard to claims 15 and 23**, they describe a jackpot wagering system and a method for operating same in which, among other things, a game of chance results in an outcome, the outcome being "one of at least" a "favorable outcome," an "unfavorable

outcome," and an "intermediate outcome." It is reasonable to assume from these limitations that a favorable outcome may never result from said game of chance. If that is the case then there is no basis for the later limitations stated in these claims in regard to what occurs when a favorable outcome results in the game of chance. Therefore it is not clear if applicants are attempting to claim at least one singular outcome or that the game of chance has a possibility of various outcomes. It should be noted that in order to positively recite multiple/various possible outcomes, such should be clearly claimed as programming that when executed by a processor causes a machine to function a certain way.

7. **Claims 16-22 and 24-30** are likewise rejected because they are dependent upon claims 15 and 23, respectively.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. **Claims 15-20 and 23-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,416,409 to *Jordan* and further in view of U.S. Patent 6,435,968 to *Torango*.

10. **In regard to claims 15, 19, 20, 23, 27 and 28**, *Jordan* discloses a method of operating a jackpot wagering system, comprising the steps of:

providing a game of chance for a plurality of players, wherein a player places a wager on a turn of the game of chance and obtains an outcome based on a random event the outcome being one of at least a favorable outcome in which the player wins the contents of an accumulation account, an intermediate outcome in which the player wins the wager at fixed odds, and an unfavorable outcome in which the player forfeits the wager (column 2, lines 15-48, 60-67; column 3, lines 1-3, describe a game of chance comprised of a primary game and a bonus game);

accumulating a portion of each wager in the accumulation account (column 2, lines 31-32);

rewarding each player participating in the game of chance who qualifies for enrollment with at least one enrollment in the lottery (column 2, lines 24-26, describing obtaining a bonus symbol in the primary game as qualifying the player for enrollment in the bonus game/lottery); and

if the favorable outcome of the game of chance occurs, awarding the contents of the accumulation account to the player who obtained the favorable outcome, cancelling the lottery, and voiding all enrollments in the lottery (column 2, lines 60-67; column 3, lines 1-3, describe the "favorable outcome" of the accrual pool being greater than the bonus threshold, and if a certain bonus symbol is won by a player that player may then win the entire accumulation award).

10. *Jordan* does not disclose

defining a time interval for a lottery associated with the game of chance;

determining whether the favorable outcome of the game of chance occurs during the defined time interval;

if the favorable outcome of the game of chance does not occur during the defined time interval, randomly selecting one of the enrollments in the lottery and awarding the contents of the accumulation account to the player with the selected enrollment as winner of the lottery;

wherein the defined time interval has a fixed duration; nor

wherein the defined time interval expires when the balance of the accumulation account exceeds a predetermined threshold.

11. *Torango* teaches

defining a time interval for a lottery associated with the game of chance (column 4, lines 35-45, describe a "boundary criterion," including that of an "expiration…time" during which a winner is determined);

determining whether the favorable outcome of the game of chance occurs during the defined time interval (column 4, lines 35-45, describe a "boundary criterion," including that of an "expiration…time" during which a winner is determined);

if the favorable outcome of the game of chance does not occur during the defined time interval, randomly selecting one of the enrollments in the lottery and awarding the contents of the accumulation account to the player with the selected enrollment as winner of the lottery (column 4, lines 35-45, describe when an expiration time is reached if random play has not created a prize award (i.e., has not generated the "favorable

outcome," as described above being disclosed by *Jordan*) to randomly select one of the current participants as a winner);

wherein the defined time interval has a fixed duration (column 4, lines 35-45); and

wherein the defined time interval expires when the balance of the accumulation account exceeds a predetermined threshold (column 4, lines 35-45).

12. At the time of invention, it would have been obvious to a person of ordinary skill in the art to add to the game of chance, as disclosed by *Jordan*, a time interval associated with winning, as taught by *Torango*, since setting a time limit in which awards would be made would increase player excitement and interest by ensuring that a prize is won in a defined time period.

13. **In regard to claims 16-18 and 24-26,** *Jordan* discloses rewarding each player participating in the game of chance who qualifies for enrollment with at least one enrollment in the lottery (column 2, lines 24-26, describing obtaining a bonus symbol in the primary game as qualifying the player for enrollment in the bonus game/lottery). The limitation of multiple enrollments in the lottery, or one for every 10 or 15 turns of the game of chance on which the player has placed a wager does not provide an unexpected result but is an obvious matter of **DESIGN CHOICE** by the designer of the game to qualify or enroll in the award price. Applicant has not disclosed how the number of enrollments granted or the number of turns required to qualify for an enrollment produces an advantage or are used for a particular purpose over that of

Jordan's rule of requiring just one play of the game to potentially qualify for the accumulation feature.

Therefore, it would have been *prima facie* obvious to modify *Jordan* in order to, instead of requiring the disclosed single play to potentially qualify for the jackpot lottery, to require multiple plays of some number (e.g., 10 or 15), or, alternatively, to award the player multiple enrollments in proportion to the player's participation.

14. **Claims 21-22 and 29-30** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Jordan* and *Torango* as applied to the claims above, and further in view of U.S. Patent 2003/009375 to *Stotlz et al.*

15. **In regard to claims 21-22 and 29-30,** the combination of *Jordan* and *Torango* teaches a progressive jackpot system that enrolls eligible players during a specific time interval as specified in the rejection above. However, *Jordan* and *Torango* lack in specifically teaching that a player enrolled in the lottery is uniquely identifiable by means of a corresponding unique code generated by a random number. In a related gaming patent, *Stoltz et al* teaches a lottery system in which enrolled players in the lottery are uniquely identified by means of a corresponding numerical code, as well as that the selection means is a random number generated and arranged so that each enrolled member has a unique code (see paragraph 5).

16. One would be motivated to incorporate a unique code for identification in order to provide the predictable result of allowing a computing device to recognize different users while participating in a game. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the unique

random number to identify players in the progressive jackpot games of *Jordan* and *Torango* with that of *Stoltz*. Furthermore, it is noted that by using a number to identify a player, the player can be tracked and their gaming information may be collected by a computer so that if the player wins the jackpot error may be relieved when contacting them to receive their rewards. Random numbers are a common way to form unique codes to identify items in electrical computing systems.

Response to Arguments

Applicant's arguments filed 10/13/2009 have been fully considered by the Examiner but are not persuasive. Applicant's representative argues that *Jordan* teaches a "bonus outcome" in the primary game, but the "'bonus outcome' does not make the player a winner of a bonus award," thus the "'bonus outcome' does not correspond to the 'favorable outcome' recited in claim 15." What is more, Applicant's representative argues that *Jordan* (emphasis original) "teaches away from using the 'bonus outcome' as a favorable outcome as recited in claim 15..." because "claim 15 recites that a lottery winner is selected if a favorable outcome does ***not*** occur during the defined time period."

Applicant's arguments are unpersuasive because the combination of *Jordan* and *Turango* teaches the limitations stated by the broadest reasonable interpretation of claim 15. The claim describes a game of chance in which there is a lottery "associated with" the game of chance. However, claim 15 fails to clarify the exact nature of this association (temporal, spatial, logical or otherwise) between the lottery and the game of

chance. In this light, the broadest reasonable interpretation of claim 15 includes an interpretation whereby the game of chance, and the outcomes associated with it, may also include those of the lottery itself.

The combination of *Jordan* and *Turango* describes a game of chance, in particular, a game of chance that combines a primary game and a bonus game. One of the outcomes of the game of chance as described by *Jordan* in view of *Turango* is of a "favorable outcome," in that if a certain bonus symbol is won by a player that player may then win the entire accumulation award. Claim 15 is, therefore, not allowable over *Jordan* in view of *Turango*, for reasons including that this prior art teaches the "favorable outcome" limitation of the claim. Likewise, claims 16-22 are also not allowable and for at least the reason that they are dependant upon a rejected claim.

Applicant's representative makes the same essential argument in regard to claim 23 as he did in regard to claim 15, and claim 23 is similarly not allowable for the reasons stated above. Likewise, claims 24-30 are also not allowable and for at least the reason that they are dependent upon a rejected claim.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mike Grant whose telephone number is 571-270-1545. The Examiner can normally be reached on Monday through Friday between 8:00 a.m. and 5:00 p.m., except on the first Friday of each bi-week.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisory Primary Examiner, Dmitri Suhol can be reached at 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MCG/

/Dmitry Suhol/

Supervisory Patent Examiner, Art Unit 3716